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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,948	10/04/2000	Jeffrey Benson	11087-029001 /027.101	7864

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EXAMINER
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GOOD JOHNSON, MOTILEWA

ART UNIT	PAPER NUMBER
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2672

14

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/679,948

Applicant(s)

BENSON ET AL.

Examiner

Motilewa A. Good-Johnson

Art Unit

2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

1. This office action is responsive to the following communications: Application, filed on 10/04/2000: Amendment A, filed 01/15/2003.

**This action is made final.**

2. Claims 1-45 are pending in this application. Claims 1 and 43-45 are independent claims. Claim 21 has been amended.
3. The present title of this application is "System and Method for Manipulating Digital Images" (as originally filed); Amendment A, filed 01/15/2003.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ofoto.com, copyright 1999, in view of Bowman, U.S. Patent Number 6,477,580.

As per independent claim 1, a method for manipulating a digital image comprising: identifying an image for processing at a local client computer; Ofoto discloses getting a photo of an image, Help: Ofoto Now 2.1, page 2; sending the image to a remote server; Ofoto discloses uploading the photo to a remote server for

processing, Help: Ofoto Now 2.1, page 2; manipulating either locally or remotely parameters . . . without modifying the image itself; Ofoto discloses editing the photo, Help: Ofoto Now 2.1, page 2, and discloses altering a copy of the photo rather than the original photo, Help: Ofoto Now 2.1, page 5; and synchronizing the local client computer and remote server . . . Ofoto discloses uploading the photo on the remote server from the local client, Help: Ofoto Now 2.1, pages 6-7.

However, it is noted that Ofoto fails to disclose metadata. Bowman discloses data including identifiers for a type of object, attribute descriptors and metadata interpretations, col. 2, lines 19-43. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the image processing of Ofoto metadata to describe attributes and identifiers for an image to reduce the amount of data transferred between the local client computer and remote server.

With respect to dependent claim 2, synchronizing step includes updating local client software for manipulating the image. Ofoto discloses uploading the information from the edit menu to update the remote server, Help: Ofoto Now 2.1, pages 6-7.

With respect to dependent claim 3, manipulating step includes manipulating a proxy image associated with the image. Ofoto discloses proxy images, Help: Ofoto Now 2.1, page 11.

With respect to dependent claim 4, proxy image is a lower resolution image than the image. Ofoto discloses viewing the image as a thumbnail image, Help: Ofoto Now 2.1, page 3.

With respect to dependent claim 5, proxy image is a higher resolution image than the image. Ofoto discloses displaying a full size display of the image, Help: Ofoto Now 2.1, page 3.

With respect to dependent claim 6, manipulating the proxy image includes creating metadata describing the manipulations to the image, applying the metadata to the proxy image . . . Ofoto discloses proxy images, Help: Ofoto Now 2.1, page 11.

With respect to dependent claim 7, manipulating step includes . . . a. selecting between the image and a proxy image . . . , b. modifying the selected image . . . , and c. displaying the modified selected image. Ofoto discloses editing the photo, Help: Ofoto Now 2.1, page 2, and discloses altering a copy of the photo rather than the original photo, Help: Ofoto Now 2.1, page 5

With respect to dependent claim 8, storing the metadata as a file associated with the image at each of the local client computer and the remote server . . . However, it is noted that Ofoto fails to disclose metadata. Bowman discloses data including identifiers for a type of object, attribute descriptors and metadata interpretations, col. 2, lines 19-43. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the image processing of Ofoto metadata to describe attributes and identifiers for an image to reduce the amount of data transferred between the local client computer and remote server.

With respect to dependent claim 9, metadata includes rotation information. Ofoto discloses rotating the image, Help: Ofoto Now 2.1, page 4.

With respect to dependent claim 10, metadata includes cropping information.

Ofoto discloses cropping the photo, Help: Ofoto Now 2.1, page 4.

With respect to dependent claim 11, metadata includes user interface state information. Ofoto Now discloses express prints and remembering purchasing preferences.

With respect to dependent claim 12, step of manipulating the parameters includes capturing state information . . . Ofoto discloses photo information, such as the data, pixel size and color depth, Help: Ofoto Now 2.1, page 8.

With respect to dependent claim 13, capturing a history of the state information and selecting any of the previous states without traversing back through each intermediary state . . . Ofoto discloses undo changes on the edit menu, Help: Ofoto Now 2.1, page 8.

With respect to dependent claim 14, parameter that can be manipulated can be selected from image parameters, account parameters and order parameters. Ofoto discloses changing account information, Help: Ofoto Now 2.1, page 1.

With respect to dependent claim 15, image parameters include the state of the user interface. Ofoto Now discloses express prints and remembering purchasing preferences.

With respect to dependent claim 16, image parameters include image archival information. Ofoto discloses photo information, Help: Ofoto Now 2.1, page 8.

With respect to dependent claim 17, image parameters include annotation information. Ofoto discloses copying the photo to a clipboard to paste into a document, Help: Ofoto Now 2.1, page 9.

With respect to dependent claim 18, image parameters include backprint information. Ofoto Now discloses express prints and remembering purchasing preferences.

With respect to dependent claim 19, image parameters include order information. Ofoto discloses buying prints and pricing information, see start tour, buy prints page.

With respect to dependent claim 20, image parameters include pricing information. Ofoto discloses buying prints and pricing information, see start tour, buy prints page.

With respect to dependent claim 21, image parameters include image archival information. Ofoto Now discloses express prints and remembering purchasing preferences.

With respect to dependent claim 22, defining a personal template that describes a particular configuration for the parameters . . . Ofoto discloses a preference option to customize the features and functions, Help: Ofoto Now 2.1, page 9.

With respect to dependent claim 23, account parameters include verification data for the client. Ofoto discloses a login feature for the client, see start tour, welcome page.

With respect to dependent claim 24, order parameters include envelope information. Ofoto discloses buying prints and pricing information, see start tour, buy prints page.

With respect to dependent claims 25 and 26, synchronization step is bi-directional (includes checking for conflicts between metadata . . .). However, it is noted that Ofoto fails to disclose synchronization steps. Bowman discloses synchronization services for supporting the user, col. 54, lines 16-23 and further discloses conflict resolution, col. 51, lines 22-23. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the image processing of Ofoto synchronization steps and checking for conflicts as disclosed in Bowman, to provide better user support services.

With respect to dependent claims 27-29, receiving a selection from the user regarding the client and synchronizing the local client computer and remote server . . . storing two different states of the metadata at each . . . alerting the user includes displaying a dialog box to the user from which a selection can be made. However, it is noted that Ofoto fails to disclose receiving a selection from the user regarding synchronizing. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the image processing of Ofoto synchronization steps and checking for conflicts as disclosed in Bowman, to provide better user support services.

With respect to dependent claim 30, a printer output file including profiles for different printers available through the remote server . . . Ofoto discloses buying prints and pricing information, see start tour, buy prints page.



With respect to dependent claim 31, displaying on both the local client computer and the remote server a similar image metaphor for manipulating the original image. However, it is noted that Ofoto fails to disclose an image metaphor for manipulating the image. Bowman-Amuah discloses a hyperlink metaphor for manipulating documents, col. 46, lines 27-33. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the image processing of Ofoto an image metaphor as disclosed in Bowman to allow for user friendly manipulations of the image.

With respect to dependent claim 32, image metaphor includes an envelope for dropping selected images into when ordering. Ofoto discloses drag and drop capabilities, Help: Add Photos, page 1.

With respect to dependent claim 33, further comprising prompting the user to experience a new remote server function . . . However, it is noted that Ofoto fails to disclose a new remote server function. Bowman-Amuah discloses tool leverage to resolve conflicts when codes are merged, col. 176, lines 61-65. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the image processing of Ofoto new server functions as disclosed in Bowman, to provide better user support services.

With respect to dependent claim 34, metadata describing the manipulations without modifying the image, the metadata being stored at the computer . . . Ofoto discloses editing the photo, Help: Ofoto Now 2.1, page 2, and discloses altering a copy of the photo rather than the original photo, Help: Ofoto Now 2.1, page 5.

With respect to dependent claim 35, local client computer is selected from the group of PDA, portable computer, kiosk, fax machine . . . Ofoto discloses the local computer runs windows and equipped with 32Mb of RAM and a video card, Help: Ofoto Now 2.1, page 1.

With respect to dependent claim 36, connection between the local client computer and remote server is wireless. Ofoto discloses uploading the photo to ophoto.com for printing, Help: Ofoto Now 2.1, page 2.

With respect to dependent claims 37-39, synchronization step occurs at a next open session (end of current session; in real time) . . . However, it is noted that Ofoto fails to disclose synchronization. Bowman-Amuah discloses replication done initiated by a user, on a scheduler and real-time replication /synchronization, col. 50, lines 14-15. It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the image processing of Ofoto, synchronization as disclosed in Bowman for better user support services.

With respect to dependent claim 40, parameters include print parameters. Ofoto discloses buying prints and pricing information, see start tour buy prints.

With respect to dependent claim 41, parameters include print calibration parameters. Ofoto discloses black and white tint, Ofoto, see start tour, view & edit albums page.

With respect to dependent claim 42, parameters include display parameters. Ofoto discloses black and white tint, Ofoto, see start tour, view & edit albums page.

As per independent claims 43-45, they are rejected based upon similar rational as above independent claim 1.

### ***Response to Arguments***

6. Applicant's arguments filed 06/18/2003 have been fully considered but they are not persuasive.

Applicant argues that Ofoto fails to disclose manipulating either locally or remotely parameters associated with the image without modifying the image itself. Ofoto allows a user in the photo tour to edit the image and undo the editing without a generated copy, but rather parameters associated with the image itself. Applicant argues that Ofoto modifies the image itself. Applicants Shutterfly modifies the image itself also. Applicant argues that Ofoto fails to synchronize the local client computer and the remote server using metadata. It is inherent that synchronization would occur between the local client computer and the remote server, so that the user would receive the correctly edited image.

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ofoto discloses

editing and manipulating images with data parameters, Bowman-Amuah discloses attaching meta-data to manipulate data. Therefore making it obvious to attach meta-data for manipulation of data parameters.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Motilewa A. Good-Johnson whose telephone number is (703) 305-3939. The examiner can normally be reached on Monday - Friday 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Razavi can be reached on (703) 305-4713. The fax phone numbers

Application/Control Number: 09/679,948  
Art Unit: 2672

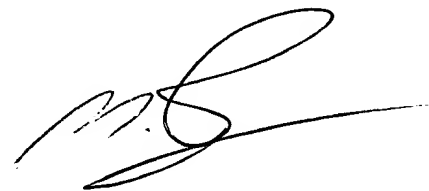
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for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Motilewa A. Good-Johnson  
Examiner  
Art Unit 2672

mgj  
September 9, 2003

A handwritten signature in black ink, appearing to read 'M. Razavi', with a long horizontal flourish extending to the right.

**MICHAEL RAZAVI**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**